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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,708	05/10/2006	Frank Kowalewski	1454.1722	3387
21171 7590 12/07/2010 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,708

Applicant(s)

KOWALEWSKI ET AL.

Examiner

Alpus H. Hsu

Art Unit

2465

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/226)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 12, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costa-Requena et al. in U.S. Pub. No. 2004/0202303 (of record), hereinafter referred to as Costa-Requena, in view of Boucher et al. in U.S. Patent no. 7,536,705 B1 (of record), hereinafter referred to as Boucher.

As per claim 12, Costa-Requena teaches a method for establishment of a communication

link from a first telecommunication device to a second telecommunication device via a telecommunication network (par. [0004]), comprising: sending a connection establishment message with a data object, which is allocated to a first subscriber, to the telecommunication network in order to establish the communication link (Fig. 4, par. [0007], SIP (session initiation protocol) INVITE to include a document via communication network (see par. [0004])); storing, after sending the connection establishment message, the data object via the telecommunication network on a data provision component (Fig. 4, par. [0007], storing the document in the data store of the server (15)); transmitting a call signaling message from the telecommunication network to the second telecommunication device providing reference information which refers to the data provision component on which the data object of the first subscriber has been stored (Fig. 4, par. [26, 34-35], INVITE with URL (uniform resource locator) sent to callee (16)); signaling the data provision component from the second telecommunication device by using the reference information requesting that the data provision component transmit the data object, which is allocated to the subscriber, to the second telecommunication device (par. [0026], callee (16) retrieves the document from the server (15) using URL); transmitting the data object from the data provision component to the second telecommunication device (Fig. 4, server (15) sending document) to callee (16)).

Costa-Requena is silent on playing the data object at the second telecommunication which is a conventional feature in the communications field for multimedia presentation.

However, Boucher, in an analogous art, discloses playing the data object at the second telecommunication device (col. 37, lines 11-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Costa-

Requena to include playing the data object at the second telecommunication device, as taught in Boucher for the purpose of displaying multimedia presentation to further enhance the system capability and performance.

As per claim 22, the claim is rejected for the same reasoning as in claim 12, except the claim is in system claim format.

As per claim 23, in addition to all features of claim 1 above, Costa-Requena also discloses the additional features of a first network signaling protocol (SIP), and a second network signaling protocol (HTTP) (par. [0002] and [0025])

5. Claims 13-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Costa-Requena-Boucher, as applied to claim 12, and further in view of Donnelly in US Pub. No. 2004/0223605 (of record), hereinafter referred to as Donnelly.

As per claims 13 and 24, Costa-Requena-Boucher discloses the method according to claim 12, but is silent on wherein the telecommunication network has a first subnetwork to which the first telecommunication device has been allocated and a second subnetwork to which the second telecommunication device has been allocated, the first and second subnetworks being connected with each other via a switching component which is a conventional feature in the communications field.

However, Donnelly, in an analogous art, discloses wherein the telecommunication network has a first subnetwork to which the first telecommunication device has been allocated and a second subnetwork to which the second telecommunication device has been allocated, the first and second subnetworks being connected with each other via a switching component (Par. [0026, 0196]), discloses that calling terminal and the called terminal can be associated with

distinct communication networks capable of supporting a connection session between each other via server (see fig. 1)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Costa-Requena-Boucher to include wherein the telecommunication network has a first subnetwork to which the first telecommunication device has been allocated and a second subnetwork to which the second telecommunication device has been allocated, the first and second subnetworks being connected with each other via a switching component, as taught in Donnelly for the purpose of allowing communication between diverse networks.

As per claim 14, Costa-Requena-Boucher-Donnelly discloses the method according to claim 13. Costa-Requena further discloses wherein the switching component performs said storing (par. [0007], server (15) contains a data store) and transmitting (Fig. 4, server (15) transmitting document).

As per claim 15, Costa-Requena-Boucher-Donnelly discloses the method according to claim 14. Costa-Requena further discloses wherein the data provision component is arranged on a network and connected to the switching component (par. [0007], server (15) contains a data store located within a communication network), and Donnelly further discloses a network based on an Internet protocol (par. [0121], server communicating via internet protocol (IP) network). Examiner maintains same motivation to combine as in claim 12.

As per claim 16, Costa-Requena-Boucher-Donnelly discloses the method according to claim 15. Costa-Requena further discloses wherein the reference information has a uniform resource identifier (i.e. URL) (Examiner understands the URL to be the reference information.

Par. [26, 34-35], INVITE with URL (uniform resource locator) sent to callee (16))

As per claim 17, Costa-Requena-Boucher-Donnelly discloses the method according to claim 16. Costa-Requena further discloses wherein the second telecommunication device is in a communication session in accordance with a session initiation protocol (par. [0004], SIP used for call setup between caller and callee).

As per claim 18, Costa-Requena-Boucher-Donnelly discloses the method according to claim 17. Costa-Requena further discloses wherein the switching component, as a call signaling message, sends an INVITE message to the second telecommunication device into which the reference information has been inserted (Fig. 4, illustrates server (14) sending an invite including URL to callee (16)).

As per claim 19, Costa-Requena-Boucher-Donnelly discloses the method according to claim 18. Boucher further discloses wherein the data object includes picture information, tone information and text information (col. 37, lines 11-25). Examiner maintains same motivation to combine as in claim 12.

As per claim 20, Costa-Requena-Boucher-Donnelly discloses the method according to claim 19. Costa-Requena further discloses wherein at least one of the first and second telecommunication devices is one of a mobile radio device, a mobile telephone or a computer with a radio module (par. Fig.4, [0021-22], discloses wireless calling between terminals (12, 16)).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Costa-Requena-Boucher- Donnelly, as applied to claim 20, and further in view of Ahmavaara in US Pub. No. 2005/0101245 (of record), hereinafter referred to as Ahmavaara.

As per claim 21, Costa-Requena-Boucher-Donnelly discloses the method according to claim 20, but is silent on wherein the telecommunication network includes a mobile radio network functioning according to one of a global system for mobile communication standard and a universal mobile telecommunications system standard, both of which are well known communication standard in mobile communication field.

Ahmavaara, from the similar field of endeavor, teaches the feature of telecommunication network including a mobile radio network functioning according to one of a global system for mobile communication standard (i.e. GSM) (par. [0004]) and a universal mobile telecommunications system standard (i.e. UTMS) (par. [0008]), and therefore, discloses the use of GSM and UTMS communication networks.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Costa-Requena-Boucher-Donnelly to include a mobile radio network functioning according to one of a global system for mobile communication standard and a universal mobile telecommunications system standard, as taught in Ahmavaara for the purpose of allowing communication between diverse networks according to conventional standards to meet the specification requirements.

7. Applicant's arguments filed September 20, 2010 have been fully considered but they are not persuasive.

In the remark, regarding the rejection of claims 12 and 22 under 35 U.S.C 103(a), the applicant mainly argues that the method disclosed in Costa-Requena et al. is provided for use by a caller terminal in **setting up a conference call for a voice call or messaging session to a caller terminal**, which includes a **conference server** functioning as Signaling node for the

conference call. Contrary to Costa-Requena, the method of claim 12 is related to a method for **establishment of a communication link from a first telecommunication device to a second telecommunication device**. The claimed data objects are not stored in a conference server, but instead in a **data provision component** (for example, a **picture server**), which stores different data objects for different subscribers (for example, **sound, picture or other information**). And the information in the data object is not related to conference information containing the participant of the conference, but may be a sound, picture or other information and the data object is not used for setup connections to the participant of the conference. Further, the claimed data objects are not used to inform a participant of a conference about the other participant of the conference and the time table of the conference. This means that the claimed data objects are completely **independent** of any controlling of functions of the communication network (conference) or information about the controlled function to the called communication device.

The examiner disagrees for the following reasoning:

First, it is the examiner's intention to broadly interpret the feature of **setting up a conference call for a voice call or messaging session between terminals via a conference server** in Costa-Requena as claimed feature of **establishment of a communication link from a first telecommunication device to a second telecommunication device**.

Second, it is the examiner's intention to interpret the data store of the server (15) (Fig. 4, par. [0007]) as the claimed data provision component, which clearly performs the same functions of storing data objects as claimed.

Third, the features of having **data provision component** (for example, a **picture server**), which stores different data objects for different subscribers (for example, **sound, picture or**

other information), and the claimed data objects being completely **independent** of any controlling of functions of the communication network or information about the controlled function to the called communication device are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In view of the above reasoning, the examiner believes that the rejections to claims 12-22 under 35 U.S.C 103(a) should all be sustained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay K. Patel can be reached on (571)272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHH

/Alpus H. Hsu/
Primary Examiner, Art Unit 2465